REMARKS/ARGUMENTS

Claims

Claims 1-26 are pending in the application.

Claims 1-26 remain in the application.

Claims 3-26 are as previously presented.

Claims 1-2 are currently amended.

Claim Rejections – 35 USC § 103

Claims 1-2, 4, 6, 9 and 12-26

Claims 1-2, 4, 6, 9 and 12-26 have been rejected under 35 USC §103(a) as being obvious over the U.S. Patent No. 6,199,045, to Michael L. Giniger et al. (hereinafter "Giniger") in view of the U.S. Patent No. 5,938,721, to William O. Dussell et al. (hereinafter "Dussell").

Section 103(a) of 35 U.S.C. reads as follows:

> **35 U.S.C. 103 Conditions for patentability; nonobvious subject matter.**
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that **the subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. (emphasis added)

Section 103(a) is pretty clear that a patent may not be granted if the difference between the invention, taken as a whole, and the prior art is such that if would be obvious.

However, section 103(a) does not allow for any prior art to be used in order to destroy the inventiveness of an invention. As a matter of fact, as recited in the MPEP §2141 II:

> When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
>
> (A) The claimed invention must be considered as a whole;
>
> (B) The references must be considered as a whole **and** must suggest the desirability and thus the obviousness of making the combination;
>
> (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
>
> (D) Reasonable expectation of success is the standard with which obviousness is determined. (emphasis added)

According to the foregoing tenets, the Applicant respectfully disagrees with the Examiner and respectfully believes that the present invention is novel and inventive.

First, when considering the obviousness of the present invention, the Examiner has to consider the claimed invention as a whole. In other words, the Examiner cannot decompose the claimed invention into individual elements and then find prior art for each of the individual elements taken independently. That would amount to the impermissible use of hindsight vision (see tenet (C) above).

In the present case, the claimed invention is a system to create and store location bookmarks wherein the bookmarks are created by the users. In the system, the user, with his/her device, retrieves his/her position generally with GPS satellites or other similar system. Once the position of the user is known, he/she adds personalized information (e.g. textual description, pictures, sound, etc.) pertaining to the retrieved location in order to create a personalized bookmark. The created bookmark can then possibly be transmitted and stored on a remote server, via a telecommunication network, for future retrieval by the creating user or by any other users. The bookmark can alternatively be directly transmitted to another user via the same telecommunication network. Thus, globally, the present invention concerns a system, and a

method therefor, wherein users **create** personalized bookmarks relating to location **of their choice**. This is a system, and a method, for creating information about user-specified locations.

Accordingly, in order to prove that the claimed invention is obvious, the Examiner has the duty to find prior art references pointing to systems wherein the information about different locations is created by the users and not by third parties.

Also, it must be borne in mind that the limitations and elements recited in the claims must not be considered individually and out of context. The limitations and elements are forming a coherent whole and it is the whole that must be examined for obviousness, not the individual limitations and elements contained therein. For example, it is not because a paper pressing machine comprises a frame, a motor and wheels that the machine would be necessary obvious in view of an automobile.

What the present invention claims is the sum of all the elements, not the elements themselves.

When the preceding arguments are taken into account, it becomes clear that the Giniger reference is not relevant prior art with respect to the patentability of the present invention. True, the Giniger reference has been published before the filing of the present invention; the Applicant does not contest that fact. However, though chronologically prior to the present invention, the Giniger reference is not relevant art with respect to the technological contribution of the present invention and therefore cannot be used as "prior art".

As a matter of fact, in the system of Giniger, the users pull the location information from an existing database whose content is created and provided by third parties. The information is thus limited to locations which were chosen by third parties and which are considered to be of interest to most people. On the contrary, in the system of the Applicant, the users create personalized location information about any locations of their choice. As long as the geographical position of the location can be determined, the system of the present invention allows its user to bookmark the location. Both systems are thus fundamentally and diametrically different. In other words,

each system points toward a completely different approach. In Giniger's invention, the user **pulls** location information from a database; in the Applicant's invention, the user **creates** location information.

Still, the Examiner argues that several elements of the present invention can be found in the system of Giniger. This, the Applicant acknowledges. Indeed, there exist some similarities between the system of Giniger and the system of the Applicant. In fact, both systems rely on mobile devices, both systems rely on GPS to obtain geographical position, both systems include databases and both systems include communication networks. However, the similarities stop there.

As mentioned by the Examiner herself on page 2 of her examination report and with respect to claim 1:

> *Giniger does not explicitly disclose:*
> *ii) means for creating data elements relating to said location.*

That all the other elements of the Applicant's system are shared by the system of Giniger is irrelevant. It is not because an inventive system shares elements with other systems that these other systems are relevant to the invention or, for that matter, render a novel system obvious.

In the present case, the Examiner makes little case of the fact that Giniger does not disclose one of the most important aspect of the present invention, namely the creation of the data elements by the user. Comparatively, it like saying that a tank, which is a tracked vehicle, would be obvious in view of a car, even though the tank uses tracks for propulsion, since both vehicles have a frame, a motor and wheels. Moreover, nowhere in Giniger's reference is it recited or even suggested, implicitly or explicitly, that the user could create location information. Without this implicit or explicit suggestion, the reference of Giniger does not comply with the second tenet of patent law (i.e. (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (emphasis added)) and therefore cannot be used as prior art.

As recited in the MPEP, the invention must be taken as a whole and not as an agglomeration of individual elements. Thus, when one takes the Applicant's invention as a whole and takes Giniger's invention as a whole, one can only conclude that both invention are fundamentally different even if they share some elements. Accordingly, the Applicant respectfully believes that the reference of Giniger should not be cited as relevant prior art since it does not teach a system similar to the Applicant's. As a matter of fact, Giniger teaches (cf. Title and Abstract, first sentence) and claims the exact opposite of the Applicant's system.

Second, as also mentioned in the MPEP, when references are combined to show obviousness, the Examiner must first consider the references as a whole and must then show that a certain desirability to combine the references exists therein.

In the present case, it is the opinion of the Applicant that the Examiner failed to consider both references as a whole. In the case of Giniger, it has already been demonstrated that he teaches a fundamentally different system wherein the location information is not created by the users but, on the contrary, the location information is pulled by the users from third parties databases. Thus, Giniger never pointed toward the creation of location information by the users and this fact must clearly be taken into consideration.

In the case of Dussell, the invention is a location-based task reminder system wherein the mobile device is adapted to provide a visual and/or an auditory message when the user is near a location where a previously scheduled task could be accomplished. More particularly, in the system of Dussell, the user can create task descriptor which contains a text or auditory message associated with a location reference. According to the Examiner, the task descriptor of Dussell can be assimilated to the bookmark of the Applicant. This is far from being the case.

Typically, the system of Dussell allows the users to associate a task with a generic location descriptor. As recited in column 7, lines 22-32:

> The present invention provides a means by which tasks can be scheduled and/or prioritized based on location. Tasks are assigned using a task descriptor (e.g., a text and/or voice message describing the task) and stored in database 10. **Typically**, the **task descriptor will include a reference indicating a location at which the task is to be accomplished**. This may be a set of geographic coordinates or, **more typically, a name of a business or other location**. To illustrate, if the task descriptor is a text message such as "PICK UP MILK", an appropriate reference might be "GROCERY STORE". (emphasis added)

In the foregoing passage, it is recited that the task descriptor is associated with a location reference, "typically, a name of a business or other location". More particularly, in the given example, the task "PICK UP MILK" is associated with the generic reference location "GROCERY STORE". In the mind of the Applicant, such a task descriptor is far from being a location bookmark. A location bookmark refers to a specific and precise set of coordinates, not any generic location such as "GROCERY STORE". We must be careful in expanding the term bookmark to include things such as the task descriptor of Dussell. Whether it is used in the context of a book or in the context of the World Wide Web, the term bookmark is always associated with a means to store a specific location (e.g. a specific page in a book, a specific URL on the World Wide Web) for future retrieval and the Applicant has not departed from that meaning. A bookmark used in a book does not refer to any chapter or to any page, it refers to a specific and precise page, different from the other pages of the book. Similarly, on the World Wide Web, a bookmark referring to a precise web site (e.g. www.uspto.gov) does not refer to any patent office web site. A location bookmark is used to identify a specific location.

Moreover, the concept of bookmark implies that it is typically created by the user and on the spot. In other words, the user will typically create a location bookmark when he or she is at the location, not before, not after. However, in the system of Dussell, it is clear that the act of associating a task (i.e. creating the text or auditory description) is not typically done when the user is at the specific location where the task could be effected. This would be absurd since there is no point in creating a reminder for a location-related task when the user is at the location. In

other words, a user won't create the task descriptor "PICK UP MILK" when he or she is at the "GROCERY STORE", he or she would simply go in the store and pick up some milk. Thus, to associate a task with a location, the location must already be known, hence, be stored *a priori* in the database. For example, to associate the task of "PICKING UP MILK" with the location reference "GROCERY STORE", the location reference "GROCERY STORE" must already be available in the database. Thus, the system of Dussell implies a two steps process wherein the step of determining the position of locations and the step of associating a task description thereto are chronologically substantially separated.

The location references in the database can come from two sources. First, as recited by Dussell at column 8, lines 27-44, the location reference can be stored during a previous trip to a particular location. In the previous example, during a previous trip to a "GROCERY STORE". Second, the location reference could be provided by third parties (column 9, lines 5-9). In any case, the location references are known prior to any addition of task description. Then, later and if necessary, the user associates a task descriptor to one of the location references of the database.

Thus, there are at least two aspects of Dussell's system that distinguish his system from the Applicant's system. First, the task descriptors of Dussell are not created on the spot and are generally not related to specific location and thus are not bookmark *per se*. Second, the task descriptor of Dussell typically refers to a generic location where the task could be accomplished. A task descriptor referring to a generic location is not a location bookmark since a location bookmark refers to a specific location. Hence, in the Applicant's opinion, the Dussell's system must be considered as a whole, i.e. a location based task information retrieval system. Still, the system of Dussell is not a location bookmarking system as claimed by the Applicant.

This leads to the second portion of the second tenet mentioned above, the desirability to combine the cited references. In the present case, the Examiner does not show such a desirability. At most, the Examiner declares that it would have been obvious to combine the references:

> *Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Dussell's means for*

creating data elements relating to location in Giniger's system enabling users to accomplish a task.

Firstly, contrary to what the Examiner wrote at the end of the preceding excerpt, the objective of the Applicant's invention is not to allow users to accomplish tasks. What the present invention enables is the creation of location bookmarks, notwithstanding the motives being such creation (e.g. bookmarking a nice view, a rendezvous point, a nice restaurant, etc.).

Secondly, if it was as obvious as the Examiner seems to believe it was, how can we explain that Giniger and/or Dussell, which, for all practical purposes, were persons skilled in the art, have not thought about the present invention before. It is to be noted that both the invention of Giniger and the invention of Dussell are substantially contemporary and thus, the technology available to Giniger was available to Dussell and vice versa. Hence, both were skilled persons and the technologies were available to both. Still, neither Giniger nor Dussell thought about developing a system wherein the users could create location bookmarks which could be stored on remote databases and/or transmitted to other users.

Thirdly, is there a desirability to combine the references of Giniger and Dussell? The answer is no. The system of Giniger is explicitly a system to retrieve information (cf. Abstract, first sentence) upon request from a user. Furthermore, nowhere in the reference of Giniger does it teach, hint or disclose that one could link a task description to some geographical coordinates in order to be reminded when the user is near the specified coordinates. In any case, the system of Giniger is a system wherein the user actively request the database for information about points of interest in the vicinity of his/her location whereas the system of Dussell is a system wherein the user is "passively", i.e. without request from the user, reminded that a predetermined task could be accomplish in a location nearby. Hence, both inventions are pointing toward different directions and both inventions solve totally different problems. There is thus no implicit nor explicit desirability to combine them in order to obtain the invention of the Applicant. That both systems share some elements with themselves and with the Applicant's system does not create the desirability.

In any case, the burden of proof in the case of obviousness is not on the Applicant, it is on the Examiner. There is no presumption of obviousness. Absent of some proofs that an invention is indeed obvious or worse, anticipated, the invention must be considered new and inventive. If the Examiner fails to show such a desirability, one must conclude that there is none. It is not enough for the Examiner to declare that combining references would be obvious, she must support her declaration with objective evidences.

Third, and with all due respect, the Applicant respectfully believes that the Examiner used hindsight to reconstruct the claimed invention with prior references. Unless she can demonstrate the desirability to combine the invention of Giniger and the invention of Dussell and how such combined inventions would point toward the Applicant's system, the Applicant must conclude that the Examiner has failed to respect the third tenet recited in the MPEP (see above). As already mentioned, it is not enough to merely declare that combining references would be obvious, it is necessary to prove such a declaration.

Furthermore, by using the reference of Giniger as relevant prior art, the Examiner does not consider the present invention and Giniger's reference as a whole since it has been previously shown that both invention are fundamentally different. In fact, the Examiner uses the Giniger's reference only to support that certain elements of the Applicant's system were disclosed by Giniger. Using this reasoning, most if not all combination and system patents would fall on obviousness grounds. Indeed, when an invention is seen only for its individual elements, it is relatively easy, *a posteriori*, to find literature showing each and every element.

In the Applicant's mind, using prior art references which are teaching away from each other and from the present invention to reject claims on obviousness grounds is an impermissible use of hindsight vision.

Lastly, with respect to the reasonable expectation of success, it is not believed to be particularly relevant to the present discussion because as shown above, the combined inventions of Giniger and Dussel would not lead a person skilled in the art of the present invention.

Notwithstanding the above, the Applicant has slightly amended claims 1 and 2 to clarify them. No new matter has been added.

Consequently, the Applicant respectfully believes that claims 1-2, 4, 6, 9 and 12-26 are fully patentable and respectfully requests that the Examiner withdraws her rejection of claims 1-2, 4, 6, 9 and 12-26.

Claims 3 and 10

Claims 3 and 10 have been rejected under 35 USC §103(a) as being obvious over Giniger in view of Dussell and in further view of the U.S. Patent No. 5,926,116, Hiroaki Kitano et al. (hereinafter "Kitano").

In an argument similar to the one presented for claims 1-2, 4, 6, 9 and 12-26, the Applicant respectfully believes that the Examiner has failed to show the desirability of combining the references of Giniger, Dussell and Kitano to obtain the claimed subject matter of claims 3 and 10. Claims 3 and 10 should therefore be considered patentable and allowable.

Claims 5 and 11

Claims 5 and 11 have been rejected under 35 USC §103(a) as being obvious over Giniger in view of Dussell, in further view of Kitano and in further view of the U.S. Patent No. 5,825,283, to Elie Cahmi (hereinafter "Cahmi").

In an argument similar to the one presented for claims 1-2, 4, 6, 9 and 12-26, the Applicant respectfully believes that the Examiner has failed to show the desirability of combining the

references of Giniger, Dussell, Kitano and Cahmi to obtain the claimed subject matter of claims 5 and 11. Claims 5 and 11 should therefore be considered patentable and allowable.

Claims 7 and 8

Claims 7 and 8 have been rejected under 35 USC §103(a) as being obvious over Giniger in view of Dussell and in further view of Cahmi.

In an argument similar to the one presented for claims 1-2, 4, 6, 9 and 12-26, the Applicant respectfully believes that the Examiner has failed to show the desirability of combining the references of Giniger, Dussell and Cahmi to obtain the claimed subject matter of claims 7 and 8. Claims 7 and 8 should therefore be considered patentable and allowable.

Conclusion

Considering the above arguments, the Applicant respectfully requests that a timely Notice of Allowance be issued in this case for all pending claims. However, should it be found necessary or practical, the Applicant kindly invites the Examiner to telephone the undersigned, Applicant's agent of record, to facilitate the advancement of the present application.

Respectfully submitted,

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